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EXAMINING GROUP #2833
ATTORNEY DOCKET NO:70140

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant : BIPPUS et al.
Serial No : 09/856,788
Filed : May 23, 2001
For : CROSSTALK SHIELDING...
Art Unit : 2833
Examiner : Truc T. Nguyen
Dated : September 24, 2003

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

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REPLY BRIEF

In response to the Examiner's Answer of July 29, 2003, Applicant has the following comments:

In the section "(11) Response To Argument", the Examiner's response refers to page and line numbers of the Appeal Brief. Applicant found that many of the beginning line numbers indicated by the Examiner's Answer did not seem to line up exactly with the paragraphs and the corresponding arguments made in the Appeal Brief. In order to identify which portions of this Reply Brief correspond to the portions of the Examiner's Answer, Applicant will use the same page and line numbers used by the Examiner's Answer.

11 - 15
Page 5 lines 10-14:

In this portion of the Appeal Brief, Applicant is only stating how Petra describes element

32. Applicant does not understand why the Examiner disagrees, or describes intended use.

¹⁶
Page 5 line 15 - Page 6 line 14:

The Examiner states that Petra's shielding "could be" established using the same technique as taught by Simmack. However Applicant notes that the mere fact that references "can be" combined or modified is not sufficient to establish obviousness, MPEP 2143.01.

¹²
Page 6 line 15 - Page 7 line 3:

The Examiner recognizes that a teaching, suggestion or motivation to modify must be found in the prior art or general knowledge. However the Examiner's Answer at this part only again states that it would have been obvious without indicating why.

Page 7 line 4 - Page 8 line 10:

The Examiner's Answer states that "a suggestion of combining several parts into an integral part for quick connection or quick assembly is deemed well known in the art". Applicant in the Appeal Brief has respectfully requested support for such a statement, and again respectfully traverses and requests support for this statement in the Examiner's Answer as permitted by MPEP 2144.03.

Page 9 lines 1 - 4:

The Examiner's Answer states that "forming in one piece an article which has formally

been formed in two pieces and put together, involves only routine skill in the art". Applicant agrees with this statement. Applicant also notes that Petra does not describe shielding plates connected to a base rail by a web and rotated approximately 90° with respect to the base rail. Therefore there is no article in the prior art which was previously formed in two pieces and then put together. Therefore the Examiner's above statement does not apply.

Page 9 lines 5 - 11:

The Examiner's Answer mentions "the conductive element" of Simmack. Applicant finds many "conductive elements" in Simmack. Elements 2, 3, 4, 7, 6 and 10 are, or could be, "conductive elements". The Examiner's Answer does not indicate which, or if all, these elements are the "conductive element".

The Examiner's Answer further states that the "skilled artisan would have been motivated" but the Examiner's Answer does not indicate where the "motivation" is found in the prior art or general knowledge. Without a showing of the motivation being present in the prior art, obviousness is not established. It is only Applicant who has shown motivation and disclosed that the present invention can be used to provide a common ground.

Page 9 lines 12 - page 10 line 3:

Regardless of how the Examiner uses the connection design of Simmack, Petra and Simmack still relate to different aspects or portions of terminal blocks. The Examiner uses Simmack to teach an interconnection between shielding plates of Petra. However Simmack

only teaches a connection between terminals 4, and not a connection between shielding plates. Therefore Simmack by itself cannot teach an interconnection between “shielding plates of Petra”.

Page 10 lines 4 - 8:

Even if Petra in Figs. 1 and 2 teach the claim spacing arrangement, Simmack does not teach a connection between that spacing arrangement. Therefore it would not be obvious to place the connection of Simmack into the spacing arrangement of Petra.

Page 10 lines 9 - 16:

The “Examiner’s combination” may clearly show claim 14, but claim 14 sets forth further features which cause the “Examiner’s combination” to further not be obvious. In particular claim 14 sets forth electrical connections or separations which are opposite to Simmack, and therefore lead a person away from the “Examiner’s combination”.

Page 10 line 7 - page 11 line 2:

The Examiner’s Answer indicates where the features of claim 15 are found in Simmack. It is Applicant’s position that the suggestion or motivation to combine is still missing.

Page 11 lines 3 - 12:

The Examiner’s Answer again indicates where in Simmack one portion of claim 17 can

be found. However, the relationship of that one portion to the other portions of claim 17 is not found in the prior art. The suggestion or motivation to combine is still missing.

Page 11 lines 13 - 21:

The Examiner's Answer indicates where the features of claim 25 can be found in Petra. However there is no suggestion or motivation to lead a person to combine all of the features of claim 25. The Examiner's Answer is just a parts list.

For all of the above reasons, the Board is respectfully requested to overrule the Examiner and to allow each of the claims 13 - 17 and 25.

Respectfully submitted
For Appellant,

By: 

Theobald Dengler
Reg. No. 34,575

TD:tf
70140.19

Enclosed: Duplicate Copies of Reply Brief
Request for Oral Hearing in Triplicate

DATED: September 24, 2003
SCARBOROUGH STATION
SCARBOROUGH, NEW YORK 10510-0827
(914) 941-5600

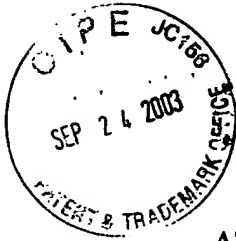
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BY: *Jon Anne Forte* DATE: September 24, 2003



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P.O. Box 1450
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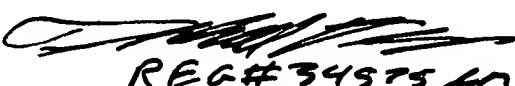
REQUEST TO CHARGE DEPOSIT ACCOUNT

In the above matter The United States Patent and Trademark Office is hereby requested
to charge deposit account 13-0410 as follows:

\$280.00 for request for oral hearing under fee code 1403.

Respectfully submitted
for Applicant,

By: _____


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JJM:tf

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DATED: September 24, 2003
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